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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,852	03/30/2001	Haruhiko Kishi	205041US-6	7025

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
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ALEXANDRIA, VA 22314

EXAMINER

TRAN, ELLEN C

ART UNIT	PAPER NUMBER
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2134

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/29/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/820,852

Applicant(s)

KISHI ET AL.

Examiner

Ellen C. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/820,852.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communication: filed on 16 October 2006 with acknowledgement of with an original application filed 30 March 2001, and of foreign application filing date of 30 March 2000.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 16 October 2006 has been entered.
3. Claims 1-20 are currently pending in this application. Claims 1, 10, 19, and 20 are independent claims. Claims 1, 10, 19, and 20 have been amended. Amendments to the claims are accepted.

Response to Arguments

4. Applicant's arguments filed 16 October 2006 have been fully considered but they are not persuasive. Applicant argues the references, in combination do not teach the claimed limitations and argues only the amended portion of the claims, see remarks pages 9-12. To address the amendments to the claims the Examiner introduces the Okabe reference, see rejection below for details. Applicant does not specifically argue against the rejection of the unamended portion of the claims, thus the Examiner, maintains the rejection of those limitations, see below rejection for details.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Down et al. US Patent No. 6,226,618 (hereinafter '618) in view of Okabe et al. U.S. Patent No. 6,889,208 (hereinafter '208).

As to independent claim 10, "An information vending method comprising the steps of" is taught in '618 col. 1, lines 51-56 "The invention disclosed broadly relates to the field of electronic commerce and more particularly to a system and related tools for the secure delivery and rights management of digital assets, such as print media, films, games, and music over global communications networks such as the Internet and the World Wide Web";

"accumulating information for sale" is shown in '618 col. 9, lines 60-65 "Electronic Digital Content Store(s) 103 are the entities who market the Content 113 through a wide variety of services or applications, such as Content 113 theme programming or electronic merchandising of Content 113. Electronic Digital Content Store(s) 103 manage the design, development, business operations, settlements, merchandising, marketing, and sales of their services. Example online Electronic Digital Content Store(s) 103 are Web sites that provide electronic downloads of software";

"generating usage conditions for said information for sale in response to a purchase selection of the information for sale; encrypting said purchase selection; generating a

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cryptographic key which decrypts said purchase selection" is disclosed in '618 col. 26, lines 16-23 and "After an End-User(s) has selected a Content 113 item for purchase, the End-User Device(s) 109 requests authorization for the Content 113 based on Store Usage Conditions 519. Before the Clearinghouse(s) 105 sends a License SC(s) 660 to the End-User(s), the Clearinghouse(s) 105 verifies that the Store Usage Conditions 519 being requested are in agreement with the allowable Usage Conditions 517 that were specified by the Content Provider(s) 101 in the Metadata SC(s)";

'618 teaches **"a portable recording medium"** in col. 11, lines 29-53;

the following is not explicitly taught in '618: **"authenticating a license management capability of a portable recording medium loaded on said information vending apparatus in one of direct and indirect manners"** however '208 teaches "A customer's player 6a can be connected to the terminal apparatus 5 via an IEEE1394 interface. The player 6a includes a computer which operates in accordance with a control program stored in a memory. The control program is designed to enable the player 6a to implement processes mentioned later. The player 6a also includes a storage unit. A predetermined ID (a predetermined identification code word) is assigned to the player 6a. In the case where the player 6a is connected with the terminal apparatus 5, the player 6a informs the terminal apparatus 5 of its own ID before downloading" and "With reference to FIG. 4, in the case where the customer's player 6a is connected with the kiosk terminal apparatus 5 via the IEEE1394 interface, the kiosk terminal apparatus 5 transmits player authentication "A" data of a form "1" to the customer's player 6a. In response to the player authentication "A" data, the customer's player 6a transmits reply player authentication "A" data and host authentication "A" data of a form "2" to the kiosk terminal apparatus ... Then, the

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communication sequence advances to either a contents transfer stage or an edited data transfer stage in accordance with operation of the kiosk terminal apparatus" in col. 7, lines 13-23 and col. 9, lines 10-48, note the 'license management capability' is the 'control program' which is authenticated first when the selling apparatus authenticates the requesting user player ID 'then' the content is sent or downloaded, the claimed 'vending apparatus' is a sales source terminal 'kiosk' taught in '208;

"and writing said purchase selection to said portable recording upon authentication along with said usage license management capability and said cryptographic key" however '208 teaches "Then, the kiosk terminal apparatus 5 transmits a sale header of a form "19" to the customer's player 6a. The customer's player 6a transmits a form-"22" signal of a data reception notice to the kiosk terminal apparatus 5 when successfully receiving the sale header. Thereafter, the kiosk terminal apparatus 5 transmits a sale sub header of a form "20" to the customer's player 6a. The customer's player 6a transmits a form-"22" signal of a data reception notice to the kiosk terminal apparatus 5 when successfully receiving the sale sub header. Then, the kiosk terminal apparatus 5 transmits contents data (encryption-resultant contents data) of a form "21" to the customer's player 6a. The customer's player 6a transmits a form-"22" signal of a data reception notice to the kiosk terminal apparatus 5 when successfully receiving the contents data. Subsequently, the kiosk terminal apparatus 5 transmits playback key data (secondary encryption-resultant playback key data) of a form "25" to the customer's player 6a" and "The program segment in FIG. 10 relates to transferring or copying data from the customer's player 6a to the customer's player 6b. As shown in FIG. 10, a first step S31 of the program segment refers to transfer control data in every sale header. The step S31 decides whether the transfer control data

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represents prohibition or permission concerning data transfer (copying)” in col. 10, lines 2-23 and col. 12, lines 2-23, note the ‘usage conditions’ are contained in the sale header, the ‘license management capability’ is the ‘control program.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify a method for securely distributing data taught in ‘618 to include a means to authenticate a recording medium prior to copying data. One of ordinary skill in the art would have been motivated to perform such a modification to prevent illegal coping of data once sold see ‘208 (col. 1, lines 40 et seq.) “It is desirable to prevent contents data from being transmitted and downloaded to an illegal customer's player. Even in the case where contents data have been transmitted and downloaded to a legitimate customer's player, it is desirable to manage copying the contents data for copyright”.

As to dependent claim 11, “further comprising communicating with a reproduction unit for reproducing said purchase selection recorded on said portable recording medium” however ‘208 teaches a second embodiment which includes a PC client, which is considered to be equivalent to the ‘reproduction unit’ and a customer player which is an obvious variation of a portable recording medium in col. 13, lines 2-5;

“wherein in said authentication step, said reproduction unit is further authenticated when in said communication step said reproduction unit is communicated” however ‘208 teaches an authentication step between reproduction unit on a portable device in col. 9, lines 10-48;

“and in said writing step, said encrypted information for sale along with said usage conditions and said cryptographic key are written to said recording medium through said

reproduction unit” however ‘208 teaches writing usage condition and cryptographic key in col. 10, lines 2-23 and col. 12, lines 2-23. The motivation to combine ‘618 and ‘208 is the same as stated above in claim 10.

As to dependent claim 12, “wherein said reproduction unit is a portable device and said portable medium being detachably loaded on said portable device” is shown in ‘618 col. 11, lines 29-53 “The End-User Device(s) 109 can be any player device that contains an End-User Player Application 195 (described later) compliant with the Secure Digital Content Electronic Distribution System 100 specifications. These devices may include PCS, set top boxes (IRDs), and Internet appliances. The End-User Player Application 195 could be implemented in software and/or consumer electronics hardware. In addition to performing play, record, and library management functions, the End-User Player Application 195 performs SC processing to enable rights management in the End-User Device(s) 109. The End-User Device(s) 109 manages the download and storage of the SCs containing the Digital Content; requests and manages receipt of the encrypted Digital Content keys from the Clearinghouse(s) 105; processes the watermark(s) every time the Digital Content is copied or played; manages the number of copies made (or deletion of the copy) in accordance with the Digital Content's Usage Conditions; and performs the copy to an external media or portable consumer device if permitted. The portable consumer device can perform a subset of the End-User Player Application 195 functions in order to process the content's Usage Conditions embedded in the watermark. The terms End-User(s) and End-User Player Application 195 are used throughout this to mean through the use or running-on an End-User Device(s) 109”.

As to dependent claim 13, “wherein in said communication step, said reproduction unit which reproduces said purchase selection recorded on said portable recording medium integrally disposed on said reproduction unit is communicated; and in said writing step, said encrypted purchase selection along with said usage conditions and said cryptographic key are written to said portable recording medium integrally disposed on said reproduction unit” is disclosed in ‘618 col. 7, lines 11-65 “The control of Content usage is enabled through the End-User Player Application 195 running on an End-User Device(s). The application embeds a digital code in every copy of the Content that defines the allowable number of secondary copies and play backs. Digital watermarking technology is used to generate the digital code, to keep it hidden from other End-User Player Application 195, and to make it resistant to alteration attempts. When the Digital Content is accessed in a compliant End-User Device(s), the End-User Player Application 195 reads the watermark to check the use restrictions and updates the watermark as required. If the requested use of the content does not comply with the usage conditions, e.g., the number of copies has been exhausted, the End-User Device(s) will not perform the request”.

As to dependent claim 14, “wherein said reproduction unit is a portable device and said storage medium is fixedly and integrally arranged on said portable device” is taught in ‘618 col. 6, lines 37-48 “The Secure Digital Content Electronic Distribution System is a technical platform that encompasses the technology, specifications, tools, and software needed for the secure delivery and rights management of Digital Content and digital content-related content to an end-user, client device. The End-User Device(s) include PCS, set top boxes (IRDs), and Internet appliances. These devices may copy the content to external media or portable,

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consumer devices as permitted by the content proprietors. The term Digital Content or simply Content, refers to information and data stored in a digital format including: pictures, movies, videos, music, programs, multimedia and games”.

As to dependent claim 15, “further comprising: receiving said information for sale supplied through a predetermined transmission path; wherein in said accumulation step, said information received by said receiving means is accumulated” is shown in ‘618 col. 26, line 35 through col. 27 line 18 “Metadata SC(s) 620 are built by Content Provider(s) 101 and are used to define Content 113 items such as songs. The Content 113 itself is not included in these SC(s) because the size of the Content 113 is typically too large for Electronic Digital Content Store(s) 103 and End-User(s) to efficiently download the containers just for the purpose of accessing the descriptive metadata. Instead, the SC(s) includes an external URL (Uniform Resource Locators) to point to the Content 113. The SC(s) also includes metadata that provides descriptive information about the Content 113 and any other associated data, such as for music, the CD cover art and/or digital audio clips in the case of song Content”.

As to dependent claim 16, “wherein said transmission path is the Internet, said information is supplied via the Internet to a server unit, and said information is received from said server unit to be stored in said accumulation step” is disclosed in ‘618 col. 26, line 35 through col. 27 line 18 “Instead, the SC(s) includes an external URL (Uniform Resource Locators) to point to the Content 113”.

As to dependent claim 17, “wherein in said usage condition generating step, said usage conditions which are employed by said reproduction unit which reproduces said purchase selection recorded on said portable recording medium are generated; and in said

encryption step, said purchase selection is accessed by use of an algorithm which allows said reproduction unit to decrypt said purchase selection” is taught in ‘618 col. 7, lines 11-55 “A SC is a cryptographic carrier of information or content that uses encryption, digital signatures, and digital certificates to provide protection against unauthorized interception or modification of electronic information and content”.

As to dependent claim 18, “wherein said information for sale includes at least one of program, voice, music, still picture, moving picture, text data” is shown in ‘618 col. 1, lines 50-57.

As to independent claim 1, this claim is directed to the apparatus of the method of claim 10 and is rejected along similar rationale.

As to dependent claims 2-9, these claims are substantially similar to claims 11-18 and are rejected along the same rationale.

As to independent claim 19, this claim is directed to a program storage medium of the method of claim 10 and is rejected along similar rationale.

As to independent claim 20, “An information vending apparatus comprising” is taught in ‘618 col. 1, lines 51-56 “The invention disclosed broadly relates to the field of electronic commerce and more particularly to a system and related tools for the secure delivery and rights management of digital assets, such as print media, films, games, and music over global communications networks such as the Internet and the World Wide Web”;

“an accumulation unit configured to accumulate information for sale” is shown in ‘618 col. 8, line 54 through col. 9, line 60 and col. 48, lines 27-67 “The encrypted Content 113, digital content-related data or metadata, and encrypted keys are packed in SCs (described below)

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by the SC Packer Tool and stored in a content hosting site and/or promotional web site for electronic distribution. The content hosting site can reside at the Content Provider(s) 101 or in multiple locations, including Electronic Digital Content Store(s) 103 and Intermediate Market Partners (not shown) facilities. Since both the Content 113 and the Keys (described below) are encrypted and packed in SCs, Electronic Digital Content Store(s) 103 or any other hosting agent can not directly access decrypted Content 113 without clearance from the Clearinghouse(s) and notification to the Content Provider(s) 101 ... Electronic Digital Content Store(s) 103 are the entities who market the Content 113 through a wide variety of services or applications, such as Content 113 theme programming or electronic merchandising of Content 113. Electronic Digital Content Store(s) 103 manage the design, development, business operations, settlements”;

“a usage condition generating unit configured to provide usage condition for said information for sale in response to a purchase selection of information for sale; an encryption unit configured to encrypt said purchase selection” is disclosed in ‘618 col. 26, lines 16-23 and “After an End-User(s) has selected a Content 113 item for purchase, the End-User Device(s) 109 requests authorization for the Content 113 based on Store Usage Conditions 519. Before the Clearinghouse(s) 105 sends a License SC(s) 660 to the End-User(s), the Clearinghouse(s) 105 verifies that the Store Usage Conditions 519 being requested are in agreement with the allowable Usage Conditions 517 that were specified by the Content Provider(s) 101 in the Metadata SC(s)”;

“an encryption key generating unit configured to generate a cryptographic key which decrypts said purchase selection” is disclosed in ‘618 col. 7, lines 11-40 “Licensing authorization and control are implemented through the use of a Clearinghouse(s) entity and

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Secure Container (SC) technology ... Only users who have decryption keys can unlock the encrypted Content, and the Clearinghouse(s) releases decryption keys only for authorized and appropriate usage requests. The Clearinghouse(s) will not clear bogus requests from unknown or unauthorized parties or requests that do not comply with the content's usage conditions as set by the content proprietors. In addition, if the SC is tampered with during its transmission, the software in the Clearinghouse(s) determines that the Content in a SC is corrupted or falsified and repudiate the transaction”;

‘618 teaches **“a portable recording medium”** in col. 11, lines 29-53;

the following is not explicitly taught in ‘618: **“an authentication unit configured to authenticate a portable recording medium directly or indirectly loaded on said information vending apparatus”** however ‘208 teaches “A customer's player 6a can be connected to the terminal apparatus 5 via an IEEE1394 interface. The player 6a includes a computer which operates in accordance with a control program stored in a memory. The control program is designed to enable the player 6a to implement processes mentioned later. The player 6a also includes a storage unit. A predetermined ID (a predetermined identification code word) is assigned to the player 6a. In the case where the player 6a is connected with the terminal apparatus 5, the player 6a informs the terminal apparatus 5 of its own ID before downloading” and “With reference to FIG. 4, in the case where the customer's player 6a is connected with the kiosk terminal apparatus 5 via the IEEE1394 interface, the kiosk terminal apparatus 5 transmits player authentication "A" data of a form "1" to the customer's player 6a. In response to the player authentication "A" data, the customer's player 6a transmits reply player authentication "A" data and host authentication "A" data of a form "2" to the kiosk terminal apparatus ... Then, the

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communication sequence advances to either a contents transfer stage or an edited data transfer stage in accordance with operation of the kiosk terminal apparatus” in col. 7, lines 13-23 and col. 9, lines 10-48, note the ‘license management capability’ is the ‘control program’ which is authenticated first when the selling apparatus authenticates the requesting user player ID ‘then’ the content is sent or downloaded, the claimed ‘vending apparatus’ is a sales source terminal ‘kiosk’ taught in ‘208;

“and a writing unit configured to write said purchase selection to said portable recording medium along with said usage conditions for said license management capability and said cryptographic key upon authentication” however ‘208 teaches “Then, the kiosk terminal apparatus 5 transmits a sale header of a form "19" to the customer's player 6a. The customer's player 6a transmits a form-"22" signal of a data reception notice to the kiosk terminal apparatus 5 when successfully receiving the sale header. Thereafter, the kiosk terminal apparatus 5 transmits a sale sub header of a form "20" to the customer's player 6a. The customer's player 6a transmits a form-"22" signal of a data reception notice to the kiosk terminal apparatus 5 when successfully receiving the sale sub header. Then, the kiosk terminal apparatus 5 transmits contents data (encryption-resultant contents data) of a form "21" to the customer's player 6a. The customer's player 6a transmits a form-"22" signal of a data reception notice to the kiosk terminal apparatus 5 when successfully receiving the contents data. Subsequently, the kiosk terminal apparatus 5 transmits playback key data (secondary encryption-resultant playback key data) of a form "25" to the customer's player 6a” and “The program segment in FIG. 10 relates to transferring or copying data from the customer's player 6a to the customer's player 6b. As shown in FIG. 10, a first step S31 of the program segment refers to transfer control data in every sale

header. The step S31 decides whether the transfer control data represents prohibition or permission concerning data transfer (copying)" in col. 10, lines 2-23 and col. 12, lines 2-23, note the 'usage conditions' are contained in the sale header, the 'license management capability' is the 'control program.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify a method for securely distributing data taught in '618 to include a means to authenticate a recording medium prior to copying data. One of ordinary skill in the art would have been motivated to perform such a modification to prevent illegal coping of data once sold see '208 (col. 1, lines 40 et seq.) "It is desirable to prevent contents data from being transmitted and downloaded to an illegal customer's player. Even in the case where contents data have been transmitted and downloaded to a legitimate customer's player, it is desirable to manage copying the contents data for copyright".

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen C Tran whose telephone number is (571) 272-3842. The examiner can normally be reached from 10:00 am to 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jacques H. Louis-Jacques can be reached on (571) 272-6962. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ellen Tran

Patent Examiner

Technology Center 2134

20 December 2006